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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,123	02/04/2002	Kazuhiro Namba	F-7309	5982

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EXAMINER	
BROCKETTI, JULIE K	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/067,123	NAMBA ET AL.	
	Examiner	Art Unit	
	Julie K Brocketti	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 February 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *04232003, 04242003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title should mention baseball and pitching.

The use of the trademarks "Shockwave" and Macromedia" have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 10 states, "A game progress control program..." A computer program is "functional descriptive material" which imparts functionality when employed as a

computer component. This type of descriptive material is nonstatutory when claimed as descriptive material *per se*. *Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759.* When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since the use of technology permits the function of the descriptive material to be realized. See MPEP 2106.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lipson, U.S. Patent No. 5,435,554. Lipson discloses a computer readable recording medium in which a game progress control program is recorded, and method to control a progress of a baseball game in which a player's team and a computer-controlled team or competitor's team alternately play offense and defense via a ball character used as a game medium (See Lipson col. 5 lines 25-29). The game progress control program comprises the following steps. A game image including a plurality of

characters are displayed on a monitor screen of a computer (See Lipson Fig. 3A). The game machine receives input of the content of instructions based on the moving operations and button operations of the player with respect to the pointing device (See Lipson Fig. 1B, col. 4 lines 66-67; col. 5 lines 1-22). The baseball game is proceeded based on the input made by the game player (See Lipson col. 5 lines 24-32). The designation of instructions for the pitching action of a pitcher character is accomplished by the operation of the pointing device when the player's team is the defensive side, the designation of instructions for the offensive action of a batter character is accomplished by the operation of the pointing device when the game player's team is the offensive side, and the selection of pitching or pickoff throw as said pitching action is accomplished by a button operation of the pointing device (See Lipson col. 5 lines 1-22) [claims 1 & 8-10]. The pointing device has at least two buttons including a first button and a second button. The selection of pitching or pickoff throw is accomplished by performing different button operations with respect to the first and second buttons (See Lipson Fig. 1B, col. 5 lines 1-6) [claim 2]. The designation of instructions for the type of ball is accomplished by the moving operation of the pointing device in cases where pitching is selected as the pitching action of the pitcher character (See Lipson col. 7 lines 13-27) [claim 3]. The designation of instructions for the course of the pitch is accomplished by the moving operation of the pointing device in cases where pitching is selected as the pitching action of the pitcher character (See Lipson

col. 10 lines 42-57) [claim 4]. The operation designating instructions for the course of the pitch is received after the pitching action of the pitcher character is initiated (See Lipson Fig. 4B; col. 10 lines 60-62) [claim 5].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lipson in view of Hirai et al., U.S. Patent No. 6,398,647 B1. Lipson discloses that the pitcher may pick off a base runner (See Lipson col. 6 lines 48-50). However, Lipson lacks in disclosing selecting a base that is to be picked off [claim 6]. Hirai teaches of a baseball game in which the player designates the base that is to be picked off by moving the operation of the pointing device in cases where a pickoff throw is selected as the pitching action of the pitcher character (See Hirai et al. col. 8 lines 66-67; col. 9 lines 1-4) [claim 6]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the pitcher to select the base at which he intends to pick off a player. The bases may have more than one runner; in these situations the pitcher must make a decision as to which runner they

wish to pick off. Consequently, it is obvious to have a computer input to inform the program of which runner the pitcher intends to pick off. By giving the pitcher a selection of which runner to pick off, the game appears more realistic to the player since this is a situation that an actual pitcher would have to contend with.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lipson in view of Birch et al., U.S. Patent No. 6,292,706 B1. Lipson discloses that various pitchers have certain special pitch qualities and that a player may gradually increase the skill level of opposing teams as the player's own skill level increases (See Lipson col. 8 lines 17-20, 27-29). Lipson lacks in specifically disclosing that the parameters that define respective abilities are set in the pitcher character and these parameters are altered in accordance with the pitching results [claim 7]. Birch teaches of a baseball game in which the parameters that define respective abilities are set in the pitcher character of the player's team and are altered in accordance with the pitching result (See col. 13 lines 65-67; col. 14 lines 10-12) [claim 7]. For example, a pitcher has an ERA parameter and based on his performance in the game, the ERA changes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the pitcher's parameters based on the pitching results in the game of Lipson. By adjusting the pitcher's parameters, the game takes on a more realistic situation in that a player may select a

certain pitcher based on his ERA and as the game progresses and the pitcher's ERA changes a player may wish to change pitchers based on the new ERA.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lipson in view of Okitsu et al., U.S. Patent No. 6,394,894 B1. Lipson discloses all the limitations of claim 8 as mentioned above but lacks in disclosing a game server [claim 8]. Okitsu et al. teaches of a game server, which is accessible from a computer operated by a player via a network (See Okitsu et al. col. 15 lines 51-53; col. 16 lines 7-16) [claim 8]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a game server in the invention of Lipson. By playing the game over a server, remote players may compete against each other while not having to be at the same location. Consequently, more players would have access to the game and be able to play the game and players can compete against a larger number of opponents.

Citation of Relevant Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Katayama, U.S. Patent No. 5,769,713.

   --Katayama discloses a baseball game in which players may choose the pitches they deliver.

2. Akada et al., U.S. Patent No. 6,120,374.

--Akada discloses a controller for use in a baseball game.

3. Ishihara et al., U.S. Patent No. 6,183,363 B1.

--Ishihara discloses a baseball game using various pitches.

4. Rimoto et al., U.S. Patent No. 6,334,813 B1.

--Rimoto discloses a baseball game wherein the place to which the ball is moved can be input.

5. Rimoto et al., U.S. Patent No. 6,340,332 B1.

--Rimoto discloses a baseball game and program.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brocketti whose telephone number is 703-308-7306. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Julie K Brocketti
Examiner
Art Unit 3713